

film does not require the presence of any other anti-tack surface coatings or additives in order to exhibit such anti-tack properties.

Cancel Claim 18.

19.(Amended) The anti-tack polyurethane film of Claim 17 wherein said antimicrobial compound is selected from the group consisting of elemental silver, silver zirconium phosphate compounds, silver-based zeolites, silver-based glasses, and any mixtures thereof.

20.(Amended) The anti-tack polyurethane film of Claim 19 wherein said antimicrobial compound is at least one silver zirconium phosphate compound.

#### REMARKS

Claims 1, 4-17, and 19-20 are pending within the present application. Claims 1, 4, 17, and 19-20 have been amended. Claim 18 has been cancelled. No Claims have been added.

Support for the amendments to Claims 1 and 17 concerning the thickness of the claimed film appears at page 6, first paragraph of the originally filed specification as well as within the claim as previously written (note that Alphasen is a silver zirconium phosphate compound). The amendments to Claims 4, 19, and 20 reflect the more specific listing of silver zirconium phosphate. Claim 19 also changes the dependency from 18 to 17. No new matter has been submitted. Nor has anything changed in terms of the breadth of scope of the claims since the

term "polyurethane film" was properly defined within the specification as requiring the same thickness limits as now present specifically within the submitted amended claims. Thus, no new search should be required, either, by the Office. Thus, it is respectfully requested that entry and due consideration thereof by the Office should be granted.

The Office has rejected Claims 1 and 7-16 under 35 U.S.C. § 102(b) as being anticipated by Krall et al. Applicants respectfully disagree with this rejection because, at best, Krall et al. teach antimicrobial-coated films only and do not teach the same extruded films as now claimed.

The Office has apparently not considered the full breadth of patentees' disclosure before concluding that they provide an anticipatory basis of rejection over the claimed invention. Close inspection of the complete disclosure, which must be exercised by the Office in assessing the actual teachings of any cited reference, shows that Krall et al. merely disclose the ability to take coated films, melt them down, and extrude the molten formulation into thick sheets for further manipulation into any desired shape or article therewith. In particular, the Example beginning on column 10 clearly states that a film of 0.25 mm (e.g., about 10 mils) is vapor deposited with a silver layer. This film is then melted, stirred, and cooled into cup-shaped articles, and not films. Thus, Krall et al. specifically do not teach films (as now specifically claimed) that include silver-based antimicrobial agents within the interior portion, only coated on the exterior portion. se rejected claims now require the presence of the antimicrobial within the interior of the film as well as specific classes of silver-based antimicrobials not taught by patentees. Thus, Krall et al. do not teach any films with the same silver-based antimicrobial within their interiors (as presently claimed), only subsequently produced plastic articles, and consequently do not

anticipate the present claims. Reconsideration and withdrawal are thus earnestly solicited.

The Office has also rejected Claims 1, 4, and 7-16 under 35 U.S.C. § 102(b) as being anticipated by Capelli '151. Applicants respectfully disagree with such a rejection simply because Capelli fails to teach the same required types of silver-based antimicrobials as now claimed. As silver nitrate is not part of the class of compounds now claimed, there is no anticipatory basis over the present claims. Furthermore, there is no suggestion and consequently no motivation provided the ordinarily skilled artisan in view of this reference, to substitute such a specific silver nitrate component with any other type of antimicrobial, let alone the three specific types within the class of compounds currently claimed either. Reconsideration and withdrawal of such a basis of rejection are therefore respectfully requested.

The Office has also rejected claims 4-6 under 35 U.S.C. § 103(a) as being unpatentable over Krall et al. in view of JP 09002537, as well as Claims 17-20 over Krall et al. in view of Folden. Krall et al., as noted above, is limited to a plastic article produced through first melting a coated plastic blank and allowing the molten formulation to cool into a desired plastic part. Films are taught only as such a blank, and are only coated, not extruded to provide any antimicrobial within the interior portion thereof. Thus, Krall et al., again, as noted previously, completely fail to provide any teaching of the same type of films now claimed.

The JP reference fails to provide any remedy for this problem as there is no suggestion that any antimicrobials as taught by this JP reference may be introduced within plastic film interiors for any reason or purpose. Since Krall et al. fail to provide the needed interior film teachings, and the JP reference fails to provide any motivation for the same interior introduction

requirements as now claimed, it is evident that such a combination of references fails to provide a proper obviousness basis over the present claims either. As such, it is respectfully submitted that not only is a proper prima facie obviousness rejection lacking in this situation, but the combination as set forth is an improper exercise of hindsight reconstruction of Applicants' own teachings.

Furthermore, the Folden reference as well fails to overcome the lack of teaching of Krall et al. in this same respect. At best, Folden teaches a plastic article (in the case, a tube, or like object) having an antimicrobial present therein. There is no suggestion that any antimicrobial could be introduced within a film, particularly a film as taught by Krall et al., which would then be melted and cooled into a plastic part (arguably, and possibly, a tube as taught by Folden). Without any motivation provided by Folden to make the same interior introductions as now claimed to produce the same anti-tack films as now claimed, there simply is no proper basis of rejection provided by this combination of references. Reconsideration and withdrawal of such improper hindsight reconstruction bases of rejection are therefore earnestly solicited.

The Office has also rejected claims 1 and 4-16 under 35 U.S.C. § 103(a) as being unpatentable over JP 11028797 in view of JP 09002537. Applicants again respectfully disagree with the Office's position mainly because the primary reference fails to teach the specific nature of the film as produced, let alone the nature of the antimicrobial present. Specifically, the primary abstract (the Japanese '797 reference) fails to mention what type of antimicrobial, if any, is present within the film portion of the film/resin mold system (used ultimately to form a hardened polyurethane article, apparently, from a resin of elongation between 300-1000%).

There is no discussion of the unique, unexpected properties Applicants discovered involving the specific silver-based antimicrobials as now claimed. Nor are there any disclosures of the importance or possible replacement of the '797 reference's antimicrobial with silver zirconium phosphate at all. Furthermore, the '537 reference fails to provide any suggestion that silver zirconium phosphate could be used for anything but relatively thick plastic articles and parts. There is no teaching or fair suggestion within this reference that films are proper selections for introduction of such solid antimicrobial compounds at all. Applicants have shown not only the importance of utilizing specific silver-based antimicrobials to provide low color, excellent anti-tack benefits within target polyurethane films, but also the ability to produce such films. Additionally, the Office has completely disregarded the proper showing of the anti-tack benefits provided by selecting the films as claimed having antimicrobial within both the interior portion and the exterior surface thereof. Such a secondary consideration of the unexpected benefits accorded such films through the presence of such antimicrobials in such discrete areas of the claimed films should be sufficient to overcome such an obviousness rejection, particularly because there is no teaching in either cited reference of the introduction of any antimicrobial within both such different areas of the target films at all. Again, the Office's position is clear impermissible hindsight reconstruction of Applicants' claimed invention by the Office. Reconsideration and withdrawal of such an improper rejection are thus respectfully requested.

**CONCLUSION**

In view of all of the previous remarks, it is respectfully submitted that the submitted amendments be duly entered and considered, and that the pending claims are now in condition for allowance. Thus, it is respectfully requested that this application be passed on to issue.

Respectfully submitted,



William S. Parks  
Attorney for Applicants  
Registration Number 37,528  
Telephone: (864) 503-1537

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**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Box Non-Fee Amendment, Commissioner of Patents, Washington, DC 20231, on December 28, 2002, along with a postcard receipt.



William S. Parks  
Attorney for Applicants

MARKED-UP VERSION OF AMENDMENTS TO 09/851,042

1.(Twice Amended) A polyurethane film exhibiting a thickness of from 10 to about 500 mils and having both an interior portion and exterior surface therein, said film comprising a silver-based inorganic antimicrobial compound in discrete areas of said film wherein at least some of said antimicrobial compound is present at [the] said exterior surface of said film and at least some of said antimicrobial is present within [the] said interior portion of said film; wherein said antimicrobial compound is selected from the group consisting of [elemental silver, silver-based ion exchange] silver zirconium phosphate compounds, silver-based zeolites, silver-based glasses, and any mixtures thereof.

4.(Amended) The polyurethane film of Claim 1 wherein said antimicrobial compound is [selected from the group consisting of] at least one [silver-based ion-exchange] silver zirconium phosphate compound.

17.(Amended) An anti-tack polyurethane film exhibiting a thickness of from 10 to about 500 mils and having both an interior portion and exterior surface therein, said film comprising a silver-based inorganic antimicrobial compound in discrete areas of said film wherein at least some of said antimicrobial compound is present at [the] said exterior surface of said film and[, optionally,] at least some of said antimicrobial is present within [the] said interior of said film; wherein said film exhibits a tackiness less than that of the same type of polyurethane film without said silver-based inorganic antimicrobial compound present at the surface thereof; and

wherein said polyurethane film does not require the presence of any other anti-tack surface coatings or additives in order to exhibit such anti-tack properties.

19.(Amended) The anti-tack polyurethane film of Claim [18] 17 wherein said antimicrobial compound is selected from the group consisting of elemental silver, [silver-based ion exchange] silver zirconium phosphate compounds, silver-based zeolites, silver-based glasses, and any mixtures thereof.

20.(Amended) The anti-tack polyurethane film of Claim 19 wherein said antimicrobial compound is [selected from the group consisting of] at least one [silver-based ion-exchange] silver zirconium phosphate compound.